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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,607	08/30/2000	Margaret Gwyn Latimer	14377.1	3027

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James B Robinson
Kimberly-Clark Worldwide Inc
401 North Lake Street
Neenah, WI 54957-0349

EXAMINER

PRATT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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1771

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DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS7

Advisory Action

Application N .

09/652,607

Applicant(s)

LATIMER ET AL.

Examiner

Christopher C Pratt

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 13-29.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues that the previous rejection should not have been made final for three main reasons. First, applicant argues that that pre-amended claim 13 "implied that the web was unbonded before corrugation" and that because the claim "could" have been construed to refer to a web unbonded prior to corrugation that it therefore, should have been. However, the examiner cannot arbitrarily read limitations into a claim. It would result in a confusing examination process and would be unfair to applicants. Limitations either exist in a claim or they do not. In this case, it did not.

Here, amendment B of paper number 4 added a limitation, which was not previously present in the claim. It is well established that claims are given their broadest reasonable interpretation. Prior to amendment B, claim 13 read, "said web is corrugated to produce folds and bonded." Amendment B added a limitation specifying the order of corrugating and bonding. This amendment changed the scope of the claims and overcame the prior art previously set forth.

The examiner notes that this is not a process claim, but a product claim, wherein applicant argues a process limitation was implied. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. Therefore, if process limitations are not specifically defined in a claim they are not given patentable weight and the examiner cannot read process limitations into the claim, because similar products can be made by different methods.

Applicant argues that Chien should have been applied against the pre-amended claims. However, before amendment B, Periers was the closest prior art to the invention, not Chien. Hundreds of references can potentially be applied to applicant's claims, especially applicant's broader claim 13 before amendment B. However, making every possible obviousness rejection would be wasteful to both the examiner and applicant. Periers was the closest prior art of record and accordingly it was applied against the claims. Applicant added limitations to amend around the closest prior art, and accordingly the next closest prior art was applied against the claims.

In the nonfinal rejection of paper number 3, Chien was cited as pertinent prior art. Applicant argues that this was misleading. However, the purpose of citing Chien was to put applicant on notice that Chien was applicable prior art. A copy of this reference was supplied and applicant was free to examine the reference and amend the claims around Chien. Instead, applicant added a limitation expressly taught by Chien. In view of the parent application, applicant should have expected the Chien rejection once the claims were amended. (Note: p 4, lines 7-10 the examiner made the same rejection in the parent application).

Second, applicant argues that because the same amendment was made to the parent divisional application that the examiner should have anticipated that said amendment would be made in the instant situation. However, it is the examiner's position that this fact points to the opposite conclusion. The purpose of filing a divisional is so that the claims can be amended to go in a different direction than the unsuccessful path taken in the first application. It seems redundant and contrary to ordinary logic to file a divisional application so that the exact same amendment can once again be made to the claims. In any event, the examiner cannot be expected to predict all of applicant possible amendments.


Thirdly, applicant argues that the final rejection prematurely cuts off prosecution. This is not persuasive for two reasons. First, applicant's entitlement to a full and fair hearing is set against a policy of compact prosecution designed in harmony with the desire to streamline the patent application process. The PTO has established a procedure that makes a second office action final when applicant proffers an amendment overcoming the grounds of rejection originally set forth, MPEP 706.07(a).

Second, applicant's arguments regarding the applicability of Chien to the instant claims has been thoroughly considered and is completely addressed in this advisory action. Therefore, applicant has been given a full and fair hearing with this communication.

With respect to the rejection over Chien, applicant argues that Chien fails to teach a lack of gaps between folds. Applicant points to embodiments wherein Chien teaches gaps between folds. The examiner concedes that Chien teaches multiple embodiments, but clearly teaches an embodiment having no gaps between folds in figs. 8-9, and 11. Also, col. 3, lines 65-68 states that adjacent corrugations are in mutual contact. Moreover, col. 3 describes the corrugating process, which can be optimized to eliminate the gaps between folds (col. 3 lines 28-30).

Applicant argues that figures 9 and 11 show a magnified version of the web on "an individualized fiber scale" and apparently believes that multiple folds are not illustrated. However, figures 9 and 11 clearly show multiple corrugations of the web. There are no gaps between these folds. This argument ignores fig. 8, which also shows the corrugated web with no gaps there between.

Applicant argues that it would not have been obvious to utilize 40-100% fusible binder fibers. Applicant argues that "applicants are the ones who have made the contribution to the art recognizing that at least 40% of the surface of the corrugated nonwoven web should be fusible fibers, to obtain compressive toughness." However, Chien specifically teaches that fusible fibers "strongly" bond adjacent corrugations together (col. 3, lines 65-68). Chien also teaches that thermo-bonding results in increased strength (col. 2, lines 3-5). Therefore, the skilled artisan would clearly understand that more fusible fibers would provide more bonding and more strength.


CHERYL A. JUSKA
PRIMARY EXAMINER